Remarks

Claim 1 - 18 were filed in this application. Claims 4, 5, 14 - 16 and 18 were withdrawn from consideration by Applicants as being drawn to a non-elected species.

Claims 1 - 3, 6 - 13 and 17 are currently pending in this application. In the Office Action dated June 16, 2004, the Examiner rejects claims 1, 2, 6, 8, 13 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Peot et al. (U.S. Patent Publication No. 2002/0170404), hereinafter *"Peot"*, or *Kelly* (U.S. Patent No. 5,862,727) in view of *Osenbruggen* (WO 99/02310)) and *Takano* (U.S. Patent No. 6,153,957). Additionally, the Examiner rejects claims 3, 7, and 9 - 12 under 35 U.S.C. § 103(a) as being unpatentable over *Peot* or *Kelly* in view of *Osenbruggen* and *Takano*, and in further view of *Inariba* (U.S. Patent No. 3,555,325). Applicants respectfully traverse this rejection.

Claims 1, 2, 6 8, 13 and 17 are rejected by the Examiner over the *Peot/Kelly/Osenbruggen/Takano* combination of references. The law is clear that a patent is to be granted unless the Patent Office can establish that the invention would have been obvious at the time it was made. MPEP § 2143 details the basic requirements necessary to establish a *prima facie* case of obviousness:

> To establish a *prima facie* of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

No suggestion or motivation to combine is found in these references. *Peot* and *Kelly* each disclose a laser arbor for a rotary saw blade that projects a narrow beam of light on a workpiece along the blade's intended cut line. The laser light contained within the laser

arbor of both the *Peot* and *Kelly* references is powered by batteries secured within the laser arbor which are electrically coupled to the laser light. If the batteries were secured to a non-rotating portion of the saw, it would be extremely difficult to maintain electrical contact with the laser light during saw operation, effectively rendering the laser arbor inoperable. Thus, *Peot* or *Kelly* teach away from Applicants' claimed invention, namely, combining a laser arbor for a rotary saw blade with a non-battery power source, such as voltage source having a portion secured to the non-rotating portion of the saw.

Moreover, the Examiner takes an impermissible leap, combining *Osenbruggen* and *Takano* with *Peot* or *Kelly* to achieve the present invention. Contrary to the contention made by the Examiner, *Osenbruggen* does not teach that a voltage source for the lamps of a power tool can be supplied "from an inductor assembly." *Osenbruggen* must be analyzed as a whole and merely suggests that an inductor assembly supplies a constant-current output to the lamps of an electric power tool. The portion of the *Osenbruggen* specification in which the Examiner relies states that "the tool itself...may supply power to the lamps," not the inductor assembly (*Osenbruggen*, pg. 13, lines 21-22).

Essentially, *Osenbruggen* suggests a design alternative to battery-supplied power wherein the lamps draw power from the same power source used to energize the tool. This suggestion is consistent with the entire *Osenbruggen* reference when viewed as whole, which teaches that power to the lamps comes from either a battery pack (built-in or separately attachable) or "from the power provided to the power tool." (*Osenbruggen*, *see* page 3, lines 12-15.)

The inductor assembly, on the other hand, is a mere afterthought addition to the *Osenbruggen* lamp circuit. Its purpose, as the *Osenbruggen* specification suggests, is to help maintain a "**constant-current output**...so that variations in tool demand do not result in variations in lamp supply" since both the power tool and the lamps are drawing power from the same source. (*Osenbruggen*, pg. 13, lines 23-24, emphasis added.) That is, in fact, what inductors do - they resist changes in current.

The Examiner's contention that "inductors work by a stator that is connected to the non-rotating part of an [sic] electric device and a rotor which is connected to a shaft of the electric device" is erroneous. An inductor is simply a coil of wire. Applicants believe that the Examiner is describing a motor or generator, rather than an inductor or an assembly of inductors. It is incorrect to describe the inductor in *Osenbruggen* as a generator in order to justify the combination with *Takano*. Although generators typically work by converting mechanical energy into electrical energy through magnetic induction, an inductor is not equivalent to a generator. Accordingly, no suggestion or motivation for the combination exists to obviate Applicants' claimed invention.

One of ordinary skill in the art would not be motivated to look to the art of brushless direct-current generators upon a careful reading of *Osenbruggen* because *Osenbruggen* fails to teach that which the Examiner asserts, i.e. the voltage source for the lamps is supplied "from an inductor assembly." Moreover, *Osenbruggen* fails to suggest that the power to the lamps is provided by a generator. Thus, there exists no suggestion or motivation to combine these references. Rather, Applicants respectfully assert that the only motivation for combining these references can be found through improper hindsight after reviewing Applicants' disclosure. Accordingly, the combination of *Kelly* or *Peot* with *Osenbruggen* and *Takano* is improper and the rejection should be withdrawn.

Claims 3, 7 and 9 - 12 are rejected as being unpatentable under 35 U.S.C. § 103(a) over *Peot* or *Kelly* in view of *Osenbruggen* and *Takano* and further in view of *Inariba*. As discussed above, claims 1 and 8 are allowable over this combination of references applied by the Examiner. As such, claims 3 and 7 depend from allowable claim 1 and claims 9 - 12 depend from allowable claim 8 and are thus in condition for allowance. Reconsideration of this rejection is respectfully requested.

Applicants submit that the claims are in condition for allowance and respectfully request a notice to that effect. If the Examiner believes that further discussion will advance the prosecution of the application, he is highly encouraged to telephone Applicants' representative at the number given below.

Respectfully submitted,

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